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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/712,286	11/12/2003	Robert J. Mills	14649	9293

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SHELDON & MAK  
9th Floor  
222 South Lake Avenue  
Pasadena, CA 91101

EXAMINER

AYRES, TIMOTHY MICHAEL

ART UNIT	PAPER NUMBER
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3637

DATE MAILED: 03/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/712,286

Applicant(s)

MILLS ET AL.

Examiner

Timothy M. Ayres

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— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 March 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/6/06 has been entered.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1, 5, 9, and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Regarding claims 1, 5, 9, and 12, the phrase "a linear manner within the walls" is indefinite, it is unclear as to how an object such as a ruler or a protractor can be within a

is applicant claiming the ruler/protractor? subcomb. - comb. problem.  
wall and it is unclear as to what a linear manner means.

### *Claim Rejections - 35 USC § 102*

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 3-5, 7, and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 5,623,881 to Huang. Huang teaches a desk with a desk top (23) and a book rack (21,22,212). A support structure (10) supports the desk top (23). The book rack (21, 22, 212) has openings (211) on a bottom wall (22). A pencil case (31) is attached to the book rack (21,22,212) via the support structure (10). The pencil case is disposed in a plane below the bottom wall (22) of the book rack (21,22,212). The pencil case (31) has a bottom wall, opposed side walls, a front wall, and a rear wall as seen in figure 3c. The pencil tray (31) has one large compartment (301) that is sized to receive a ruler or protractor in a linear manner and the tray has many smaller compartments. The pencil case (31) is outside the front of the book rack as seen in figure 5c.

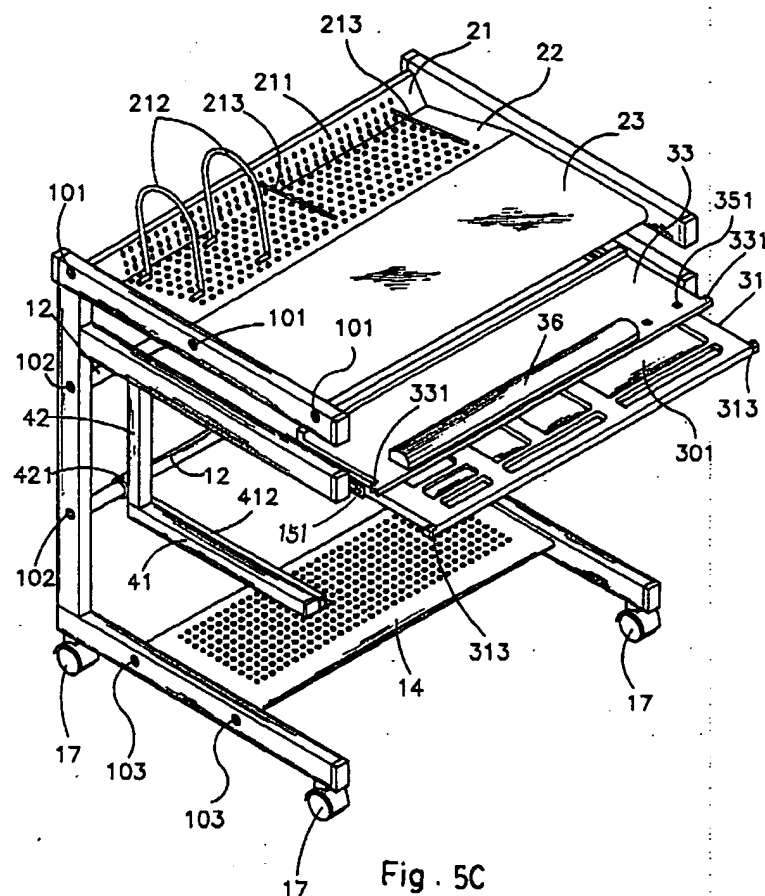
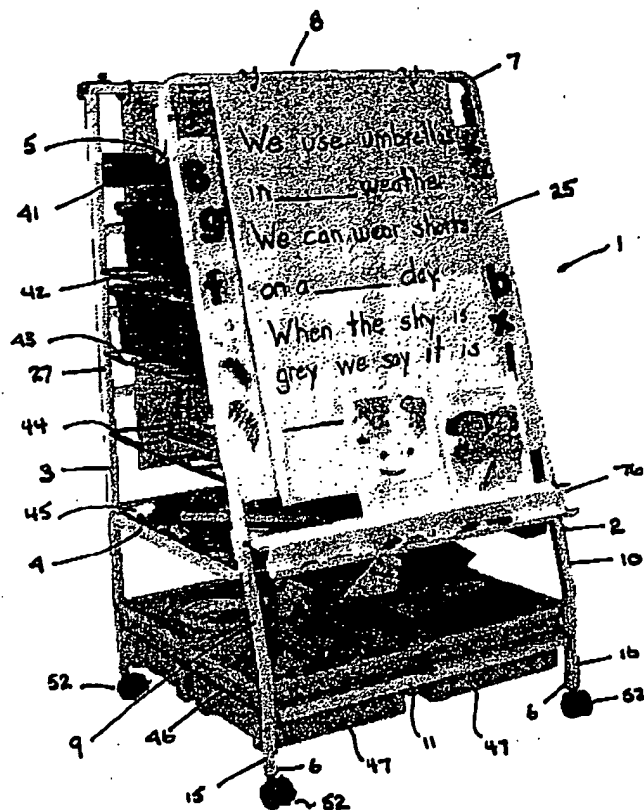


Fig. 5C

Huang '881 Figure 5c

7. Claims 1 is rejected under 35 U.S.C. 102(e) as being anticipated by US Patent Publication 2003/0177959 to Phillips. Phillips teaches a book rack (1) that has a bottom wall (46) with 4 openings as seen in figures 1 and 6. A pencil case (47) is attached to the book rack (1) and is sized to receive a ruler or a protractor in a linear manner. The pencil case has a bottom wall, opposed side walls, a front wall, and a rear wall as seen in figures 1 and 8. A portion of the pencil case (47) is below the bottom wall (46) of the book rack (1) as seen in figure 1.

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Phillips '959 Figure 1

### Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

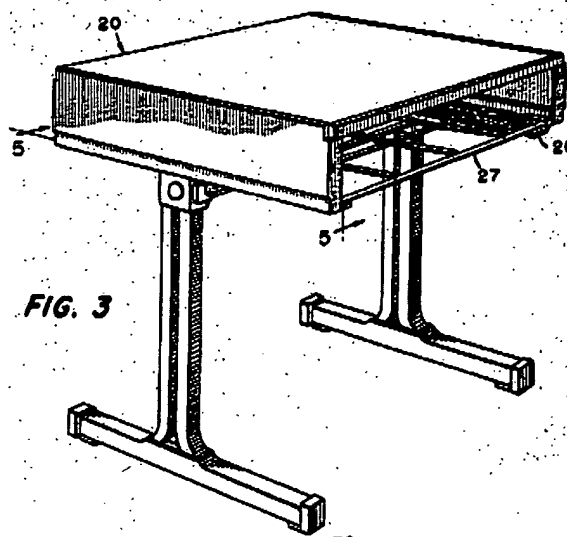
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 3,758,182 to Barecki in view of US Patent 2,535,743 to Lundahl and US Patent 6,056,178 to Rapp-Duncan. . Barecki ('182) teaches in Fig. 3, a desk (20) with a top (21) and a support structure (24). The desk (20) is bottomless with support runners (26) that define the front opening. The runners (26) support a bottom rack (27), which is made of wire mesh and has many openings. In figures 6 and 7 Barecki teaches a pencil case (28) that could replace the bottom rack (27) on the desk and thus is teaching a desire to have a pencil case in that location.

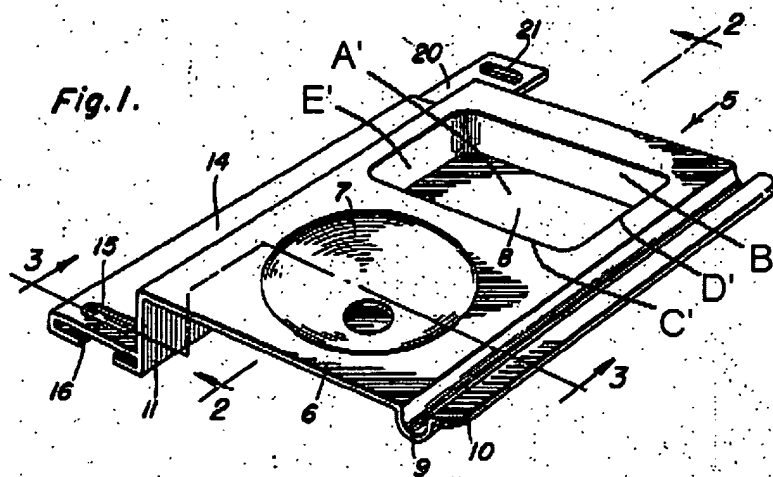


Barecki ('182) Fig. 3

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11. Barecki ('182) does not disclose expressly a pencil case attached with a pencil case attachment plate to the bookrack, a portion of the pencil case being disposed below the bottom wall of the book rack, and the pencil case with a bottom wall, a pair of opposed side walls, a front wall and a rear wall.

12. Lundahl teaches a pencil case (5) that has a portion (14) that is below the bottom of the typewriter (13). The pencil case (5) has a bottom wall (A'), opposing side walls (B', C'), a front wall (D'), and a rear wall (E'). The pencil case is sized to retain a ruler or protractor in a linear manner within the walls. Rulers and protractors come in many sizes including some that are relatively small. A linear manner does not mean the ruler or protractor have to be lying flat within the walls. Also note; a change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955). The pencil case is comprised of an upper compartment (8) and a lower compartment (7). The lower compartment (7) is disposed next to or outside the typewriter (13).



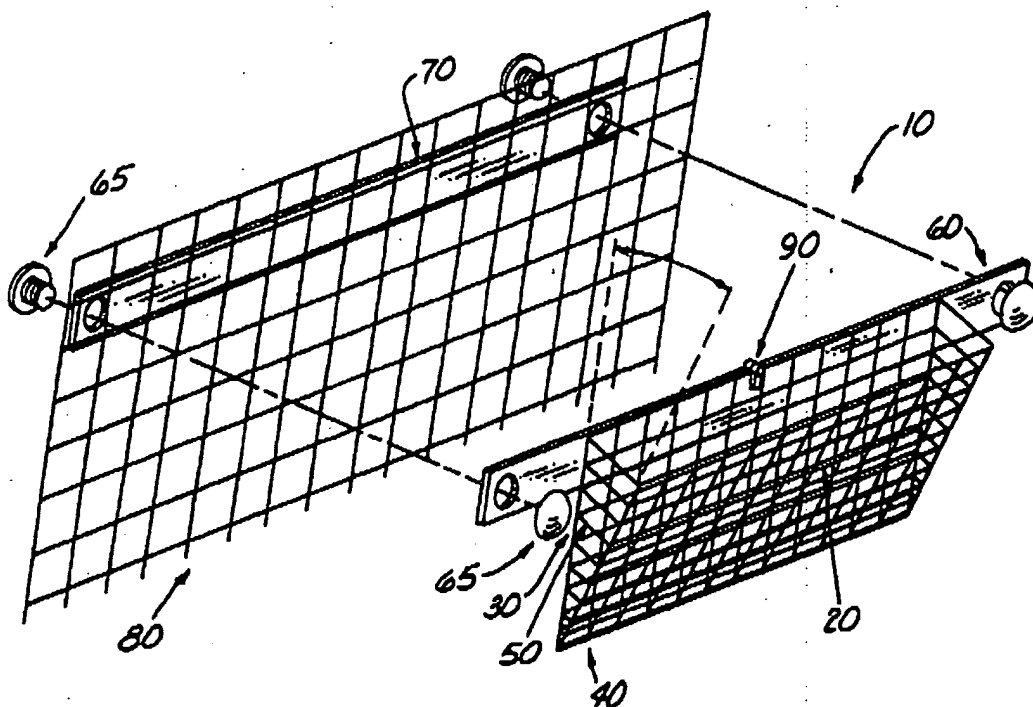
Lundahl '743 Figure 1



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13. Rapp-Duncan teaches an auxiliary bin for a shopping cart. The shopping cart (80) is made form wire mesh. The bin (10) is made form a smaller wire mesh and is attached to a bar (60). The wire mesh shopping cart (80) is sandwiched between a attachment plate (70) and the bar (60) on the bin (10).

14. At the time of the invention it would have been obvious for a person of ordinary skill in the art to modify the desk and book rack of Barecki by adding the pencil case as taught by Lundahl in the manner as taught by Rapp-Duncan since the pencil case would allow items such as pencils to be kept near the desk (Lundahl '743, col. 1, lines 7-20) and the attachment would be simple (Rapp-Duncan '178, Col. 2, lines 31-33).



Rapp-Duncan '178 Figure 1

15. Regarding claims 4, 8, 11, and 14, at the time of the invention it would have been obvious for a person of ordinary skill in the art to modify the book rack and pencil case of Barecki in view of Lundahl and Rapp-Duncan by removing the flange (11) on the pencil case (5) since the purpose of the flange (11) was to raise the compartments off of the tabletop and in the current location this is not needed and it would be cheaper and easier to manufacture with out the flange (Lundahl '743, Col. 2, lines 9-13). This would casue the lower compartment to be in a plane below a plane of the bottom of the book rack.

### ***Response to Arguments***

16. Applicant's arguments with respect to claims 1-14 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US Patent 2,683,640 to Mangine teaches a pencial case that is attached to a tabletop by a clamp. US Patent 5,494,308 teaches a bin attached to a wire mesh shopping cart in similar manner as claimed. US Patent publication 2004/0035332 to Lin teaches a desk with a book rack and pencil case. US Patent 5,263,578 to Narvey teaches pencil case with multiple levels that hangs from a shopping cart. US Patent

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5,265,735 to Hassel teaches multiple compartments at different levels for receiving items such as rulers or pencils.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy M. Ayres whose telephone number is (571) 272-8299. The examiner can normally be reached on MON-THU 8:00 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on (571) 272-6867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TMA  
3/15/06



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